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CASELLA & HESPO LLP 274 MADISON AVENUE SUITE 1703 NEW YORK, NY 10016			BASEHOAR, ADAM L	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,753

Applicant(s)

CHAUCHARD ET AL.

Examiner

Adam L. Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-14, and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The RCE filed 07/05/06.
2. Claim 19 has been added as necessitated by Amendment.
3. Claims 6-7 have been cancelled as necessitated by Amendment.
4. The rejection of claims 1-14 and 17-18 under 35 U.S.C. 103(a) as being unpatentable over Lee (US-7,016,851 03/21/06) in view of the USPTO's, "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp. 11 has been withdrawn as necessitated by Amendment.
5. Claims 1-14 and 17-19 are pending in the case. Claims 1, 14, and 19 are independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 8-14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US-7,016,851 03/21/06) in view of the USPTO's, "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp. 1-11 (The Printed archived Web Pages show the automated USPTO's Trademark Electronic Application System and will

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hereafter be referenced as “TEAS”) in further view of “Frequently Asked Questions About Trademarks”, 02/11/00, pp. 1-42 (The printed archived Web Pages show the FAQ page linked from the corresponding TEAS system discussed above and will hereafter be referenced as “FAQ”).

-In regard to independent claim 1, Lee teaches a process for registering a trademark by means of a local computer (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”);

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: “Associate A”, “Associate B”) being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: “attorneys or agents.....given jurisdiction”; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: “Associate A”, “Associate B”) to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”).

Lee does not specifically teach selecting at least one displayed heading of at least one official class of products or services to which the trademark applies; displaying a corresponding

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number of the at least one official class in the trademark registration application; and validating the entry and the selection. TEAS teaches selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: "International Class" and "Listing of Goods and/or Services") and validating the entry and the selection (Page 8: "Validate Form"). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the "International Class" entry box in the application). TEAS further teaches wherein displaying a corresponding number of the at least one official class via a search for acceptable identification of goods and services (Pages 10-11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

Neither Lee nor TEAS specifically teaches selecting one displayed heading of official class of products. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products (Pages 12-38: e.g. "Toys and sporting goods", "Meats and processed foods", etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system to have entered an official displayed heading of goods, because the headings listed by FAQ are an internationally

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recognized standard for classification and thus the classifications would be recognized the by national administrative office that the application was submitted to.

-In regard to dependent claim 2, Lee teaches cooperation between the local computer and the remote computer (Fig. 2).

-In regard to dependent claim 3, Lee teaches the validated entry and selection being re-transmitted from the remote computer to another remote computer by electronic mail (column 10, lines 59-67; column 11, lines 1-6).

-In regard to dependent claim 4, Lee teaches scanning formal documents for the trademark application (Fig. 2: 232). Lee does not specifically teach wherein the scanner was used to scan a model of the trademark. It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the scanner of Lee, to have used it to scan the model of the trademark, because it was notoriously well known in the art at the time of the invention that for an application for a trademark to be complete a model/drawing/representation of the mark needed to be included in the application and that a scanner would be an alternative way to enter the model/drawing into the application.

-In regard to dependent claim 5, Lee teaches transmission to the remote computer of the scanned model of the trademark, via the computer network (Fig. 2).

-In regard to dependent claim 8, Lee does not teach entering at least one freely chosen wording and comparing said freely chosen wording with the potential wordings contained in a file; displaying words proposed from among potential wordings; selecting at least one wording from among the wordings proposed; and displaying the number of the official class corresponding to the wordings selected. TEAS teaches:

entering at least one freely chosen wording (Page 4: "Listing of Goods and/or Services"; Page 10: "Please enter any word....services");

comparing said freely chosen wording with the potential wordings contained in a file (Page 10: "searchable index");

displaying words proposed from among potential wordings (Page 11: e.g. "Table Tennis Balls");

selecting at least one wording from among the wordings proposed (Page 11: i.e. user could select the identification code and listed potential goods which best matches search query term);

displaying the number of the official class corresponding to the wordings selected (Page 11: "028").

It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 9, Lee does not teach file containing the wordings of the official classification of trademarks and the number of the class corresponding to each wording. TEAS teaches file (Page 10: "searchable index") containing wordings of classification of trademarks and the number of the class corresponding to each wording (Page 11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

TEAS does not teach wherein the wordings of the file contain the official classification. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products (Pages 12-38: e.g. "Toys and sporting goods", "Meats and processed foods", etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system have been shown the wordings of the official classification as a result of the search, because the headings listed by FAQ are an internationally recognized standard for classification and thus the classifications would be recognized the by national administrative office that the application was submitted to.

-In regard to dependent claim 10, TEAS teaches wherein the file further includes additional wordings not featuring in the official classification of trademarks and the number of the class corresponding to each of these additional wordings (Page 11: e.g. “028”, “Table tennis bats”, “Table tennis tables”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 11, TEAS teaches using comparison software permitting a display of a proposed wording identical with the freely chosen wording (Page 11: “table tennis” and “Table tennis”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim TEAS, Lee teaches wherein the comparison permits the display of a proposed wording including the freely chosen wording (Page 11: i.e. shows “Table tennis bats” and “Table tennis balls” with the freely chosen wording of “table tennis”). It would

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have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 13, TEAS teaches wherein the software permits the display of a proposed wording synonymous with the freely chosen wording (Page 11: e.g. "Table tennis paddles" and "Table tennis rackets"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to independent claim 14, Lee teaches a process for preparing a trademark application to be filed at a national administrative department (Fig. 2: 241, 253: "EPO", "JPO"), (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO");

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sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: “Associate A”, “Associate B”) being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: “attorneys or agents.....given jurisdiction”; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: “Associate A”, “Associate B”) to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”).

Lee does not teach entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies and comparing said freely chosen wording with the potential wordings contained in a file of at least one official class of products and services; selecting at least one wording from among the displayed wordings proposed and entering the selected wordings in the trademark application; displaying the number of the official class corresponding to the wordings selected in the trademark registration application; and validating the entry and the selection. TEAS teaches entering at least one freely chosen wording (Page 4: “Listing of Goods and/or Services”; Page 10: “Please enter any word....services”); comparing said freely chosen wording with the potential wordings contained in a file (Page 10: “searchable index”); displaying words proposed from among potential wordings (Page 11: e.g. “Table Tennis Balls”); selecting at least one wording from among the displayed wordings proposed (Page 11: i.e. user could select the identification code and listed potential goods which best matches search query term); displaying the number of the official

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class corresponding to the wordings selected (Page 11: "028"); and validating the entry and the selection (Page 8: "Validate Form"). TEAS also teaches wherein the selected wordings and the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter the selected displayed wordings in the "Listing of Goods and/or Services" text box as well as the known corresponding class in the "International Class" entry box in the application). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claims 17 and 18, Lee teaches transmission to the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") an identity of the trademark applicant to complete the registration file and the retransmitting step includes transmission of the identity of the trademark applicant from the premises of the IP attorney (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9) to the another remote computer (Fig. 2: 241, 253: "EPO", "JPO").

-In regard to independent 19, Lee teaches a process for registering a trademark by means of a local computer (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253,

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etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”);

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: “Associate A”, “Associate B”) being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: “attorneys or agents.....given jurisdiction”; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: “Associate A”, “Associate B”) to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: “EPO”, “JPO”).

Lee does not specifically teach selecting at least one displayed number of at least one official class of products or services to which the trademark applies and displaying a corresponding heading of the at least one official class in the trademark registration application and validating the entry and selection. TEAS teaches selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: “International Class” and “Listing of Goods and/or Services”) and validating the entry and the selection (Page 8: “Validate Form”). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark

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registration application (Page 4: i.e. user could enter known corresponding class in the “International Class” entry box in the application). TEAS further teaches wherein displaying a corresponding number of the at least one official class via a search for acceptable identification of goods and services (Pages 10-11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

TEAS does not specifically teach selecting a displayed one number of an official class and displaying a corresponding heading of the class in application. FAQ teaches that a user utilizing the TEAS system could select the “Listing of Goods and/or Services” link (Page 4) and retrieve the FAQ page from which a user could select one of a displayed official class number (i.e. “28”, “29”, etc) and selecting a displayed heading of an official class of products (Pages 12-38: e.g. “Toys and sporting goods”, “Meats and processed foods”, etc.) It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the TEAS system have been shown the wordings of the official classification, because the headings listed by FAQ are an internationally recognized standard for classification and thus the classifications would be recognized the by national administrative office that the application was submitted to.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 14, and 19 have been considered but are moot in view of the new ground(s) of rejection.

-In reference to the archived web page references, the Examiner wishes to clarify for the applicant the connection between said references. Specifically, pages 10-11 of the TEAS reference are a result of a user utilizing pages 1-9 of the TEAS reference, wherein when a user selected the "International Class" link (e.g. Page 4), the user was then able to search for acceptable identification of goods and services. The user of the TEAS system could also access this search tool by having selected the "Listing of Goods and/or Services" link (e.g. page 4). The newly added FAQ reference could be selected from the TEAS reference by having selected the "Listing of Goods and/or Services" link (e.g. page 4). As clearly shown in the reference, a listing of all goods with official headings and international classification numbers are listed for a user to select.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. "the user can not select a choice and have it automatically transferred to the form or select a choice right in the form") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In general the Examiner believes all the limitations of the claims to be clearly taught by the combination of the listed references as currently claimed. Where the Applicant argues how the data is input into the trademark

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application, the Examiner notes that claims do not precluded a user from viewing a listing of an official heading or class and typing the data into the trademark application.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-2006/0085220	04-2006	Frank et al.
US-2003/0204813	10-2003	Krause et al.
US-6,049,811	04-2000	Petruzzi et al

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER